

REMARKS

I.           Summary of the Office Action

Claims 1-145 are pending in this application.

Claims 1-15, 17-29, 31, 32, 35, 36, 42-52, 54-65, 67-72, 75-80, 83-85, 98-125, 127, 128 and 131-138 were rejected under 35 U.S.C. § 103(a) as being unpatentable over LaJoie et al. U.S. Patent No. 5,850,218 (hereinafter "LaJoie") in view of Walter U.S. Patent No. 4,506,387 (hereinafter "Walter"). Claims 42-48, 90-97 and 138-144 were rejected under 35 U.S.C. § 103(a) as being unpatentable over LaJoie in view of Walter in further view of Florin et al. U.S. Patent No. 5,583,560 (hereinafter "Florin").

Claims 49 and 97 were rejected under 35 U.S.C. § 103(a) as being unpatentable over LaJoie in view of Walter in further view of Florin in further view of Alexander et al. U.S. Patent No. 6,177,931. Claims 5 and 53 were rejected under 35 U.S.C. § 103(a) as being unpatentable over LaJoie in view of Walter in further view of Dunn et al. U.S. Patent No. 6,571,390. Claims 16 and 66 were rejected under 35 U.S.C. § 103(a) as being unpatentable over LaJoie in view of Walter in further view of Yates et al. U.S. Patent No. 6,330,586.

Claims 30, 38-41, 73, 74, 78, 86-89 and 126 are rejected under 35 U.S.C. § 103(a) as being unpatentable over LaJoie in view of Walter in further view of Smith U.S. Patent No. 5,982,303.

Claims 33, 34, 81, 82, 129 and 130 are rejected under 35 U.S.C. § 103(a) as being unpatentable over LaJoie in view of Walter in further view of an article titled "Windows 98 pricing holds the line" from News.com.

II. Summary of Applicant's Reply to Office Action

Claims 27, 42, 75, 90, 123, and 138 have been amended. No new matter has been added and the new claims are fully supported and justified by the specification. The Examiner's rejections are respectfully traversed.

III. LaJoie Does Not Disclose Displaying At Least One Video-On-Demand Program Listing

Common to all of applicant's claims is applicant's interactive television program guide feature of displaying "at least one video-on-demand program listing." The Examiner contends that "LaJoie inherently includes means for displaying VOD program listings in Figure 5 . . . and that the electronic program guide reads service, channel and descriptive information by referring to column 125 in table 103" (June 6,

2003 Office Action, page 4). Applicant respectfully submits that FIG. 5 has nothing to do with program listings. FIG. 5 of LaJoie refers to "channel look-up tables" that are used by the set-top terminal to identify networks and services associated with particular channels (LaJoie, column 16, lines 10-16). These tables simply track which network or service is provided on which channel. Thus, using these tables, the set-top terminal can only inform the program guide that a particular channel is a VOD service (LaJoie, column 16, lines 12-24). This does not mean that the program guide can provide program listings for programs provided on those VOD channels. Rather, program listing information is part of the program guide data. LaJoie does not show or suggest that VOD program listings are part of the program guide data. More importantly, VOD program listings would not have been included in the program guide data because LaJoie states that VOD is a feature that is a separate and distinct service and only relies on these channel look-up tables to provide channel information for a VOD service (LaJoie, column 16, lines 45-51).

Applicant respectfully requests that for at least this reason, the rejections under 35 U.S.C. § 103(a) of all of the independent claims should be withdrawn because LaJoie does

not disclose displaying "at least one video-on-demand program listing" which each independent claim requires. The dependent claims are allowable at least because the independent claims are allowable.

Further patentable features and embodiments are discussed below in the sections that address the Examiner's claim rejections.

IV.        The Rejection of Claims 1-26, 50-72,  
and 98-122 Under 35 U.S.C. § 103

Independent claims 1, 50, and 98 are directed towards displaying a television program while simultaneously displaying, in a partial screen program guide, at least one VOD program listing. For example, a viewer can watch a selected television program while browsing automatically updated text descriptions of VOD programs. The interactive television program guide system then displays a VOD program immediately when the viewer selects the VOD program listing. Further patentable features and embodiments are set forth in dependent claims 2-26, 51-72, and 99-122.

The Examiner correctly acknowledges the novelty of applicant's approaches over LaJoie in stating that LaJoie fails to disclose "displaying a VOD program immediately when a user

selects a VOD listing" (June 6, 2003 Office Action, page 4). Nevertheless, the Examiner contends that this deficiency can be made up with Walter. However, as stated above in section III, applicant respectfully submits that the deficiency in LaJoie is that LaJoie does not display at least one VOD program listing. Since Walter does not show or suggest an interactive television program guide that displays at least one VOD program listing, the LaJoie-Walter combination still does not show or suggest applicant's feature of "displaying at least one video-on-demand program listing." Furthermore, applicant respectfully submits that since the LaJoie-Walter combination does not show or suggest displaying at least one VOD program listing, this combination cannot show or suggest displaying a VOD program immediately in response to a viewer selecting a VOD program listing.

Applicant respectfully submits that the § 103 rejection must be withdrawn for another independent reason. The Office Action failed to provide sufficient motivation for combining the references to justify the assertion of a § 103 rejection. In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998) ("When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or

motivation to combine the references"); see also MPEP § 2142 and 2143.01. It is well-settled that an Office Action can "satisfy this burden only by showing some objective teaching ... that would lead [one of ordinary skill in the art] to combine the relevant teachings of the references." In re Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988).

The Office Action, instead of providing objective evidence of a motivation to combine LaJoie with Walter, merely relies on various conclusions of obviousness that simply states the benefits of applicant's invention:

Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify LaJoie to allow a user to view a program after selection as taught by Walter thereby allowing a user to watch a program whenever they wanted. (June 6, 2003 Office Action, page 4)

Such "[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'" of a motivation to combine. In addition, relying solely on applicant's "disclosure as a blueprint for piecing together the prior art to defeat patentability" is insufficient as a matter of law. In re Kotzab, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999); see also In re Lee, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) ("The

factual inquiry of whether to combine references must be thorough and searching"); MPEP § 2143.

Accordingly, for at least these reasons, applicant respectfully requests that the rejection of claims 1, 50, and 98 under 35 U.S.C. § 103(a) be withdrawn.

Claims 2-26 are dependent from claim 1 and are allowable at least because claim 1 is allowable. Claims 51-72 are dependent from claim 50 and are allowable at least because claim 50 is allowable. Claims 99-122 are dependent from claim 98 and are allowable at least because claim 98 is allowable.

V.            The Rejection of Claims 27-41, 75-89,  
and 123-137 Under 35 U.S.C. § 103

Independent claims 27, 75, and 123 are directed to allowing a user to advance order a VOD program that is represented by a VOD program listing. In response to receiving a request from the viewer to advance order the VOD program, the viewer is allowed to input a start-time to display the VOD program, wherein the start-time is not a predetermined broadcast time. For example, the viewer may be provided with a program start time input field that requires a "numeric input" by the viewer to set a desired start-time for a VOD program (Applicant's specification, page 23, lines 19-22). Further

patentable features and embodiments are set forth in dependent claims 28-41, 76-89, and 124-137.

The Examiner contends that FIG. 28 of LaJoie shows a viewer "[selecting] the time to display [a VOD program]" (June 6, 2003 Office Action, page 7). Applicant submits that FIG. 28 of LaJoie shows a pay-per-view interface that allows the "user to select . . . a time from a list of times 568" (LaJoie, column 31, lines 33-38) (e.g., selecting between the program guide's predetermined show times of 1:00 PM and 3:00 PM). In the pay-per-view interface of LaJoie, the start-time is scheduled by the cable service provider and these predetermined start-time options are provided to the user via the program guide. In applicant's approaches of independent claims 27, 75, and 123, "the start-time is not a predetermined broadcast time." Because the program of applicant's approaches is a VOD program, not a pay-per-view program, it is not restricted to start-times that are prescheduled by the cable service provider. For at least this reason, applicant respectfully requests that the rejection of claims 27, 75, and 123 under 35 U.S.C. § 103(a) be withdrawn.

Claims 28, 29, 31, 32, 35, and 36 are dependent from claim 27 and are allowable at least because claim 27 is



allowable. Claims 76-80 and 83-85 are dependent from claim 75 and are allowable at least because claim 75 is allowable. Claims 124, 125, 127, 128, and 131-137 are dependent from claim 123 and are allowable at least because claim 123 is allowable.

VI.            The Rejection of Claims 42-49, 90-97,  
and 138-145 Under 35 U.S.C. § 103

Independent claims 42, 90, and 138 are directed to providing a video clip preview of a VOD program. In particular, a viewer is provided with a program guide display that includes at least one VOD program listing. The viewer may be allowed to request a video clip preview of a VOD program represented by a VOD program listing. The viewer may also be provided with an indicator that the video clip preview is available for the VOD program represented by the VOD listing wherein the indicator is displayed with the VOD program listing. For example, the viewer may be provided "a video clip icon to indicate that the listed program has an associated video clip preview" (Applicant's specification, page 21, lines 20-23). Further patentable features and embodiments are set forth in dependent claims 43-49, 91-97, and 139-145.

The Examiner attempts to modify LaJoie with the disclosure of Florin to show applicant's approaches. More

particularly, the Examiner contends that Florin "includes a preview icon which allows a subscriber to request playback of a trailer for a VOD program" (June 6, 2003 Office Action, page 13). However, applicant respectfully submits that as shown in FIG. 38 and as described in the accompanying text, the preview icon appears only after the pay-per-view program listing has been selected. This point is plainly shown since the icon is displayed in a separate display screen from which the pay-per-view program listing was displayed. Applicant's approaches are patentable over the LaJoie-Florin combination because applicant has amended claims 42, 90 and 138 to recite that the indicator that a video clip preview is available for the VOD program is "displayed with the video-on-demand program listing."

Therefore, the LaJoie-Florin combination is different from applicant's approaches. The LaJoie-Florin combination shows a preview icon that is not displayed with a program listing and is only displayed in a separate display screen from the program listing after a program listing is selected. For at least this reason, applicant respectfully requests that the rejection of claims 42, 90 and 138 under 35 U.S.C. § 103(a) be withdrawn.

The Examiner also attempts to provide the motivation to combine LaJoie and Florin in stating that they "[b]oth teach

interfaces for purchasing a movie to watch and each offer a preview function" (June 6, 2003 Office Action, page 3). This is at best a statement that the two references are in the same field of endeavor. It does not explain why one skilled in the art would be motivated to combine LaJoie with Florin.

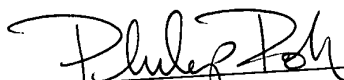
Accordingly, for at least these reasons, applicant respectfully requests that the rejection of claims 42, 90, and 138 under 35 U.S.C. § 103(a) be withdrawn.

Claims 43-49 are dependent from claim 42 and are allowable at least because claim 42 is allowable. Claims 91-97 are dependent from claim 90 and are allowable at least because claim 90 is allowable. Claims 139-145 are dependent from claim 138 and are allowable at least because claim 138 is allowable.

VII. Conclusion

In view of the foregoing, claims 1-145 are in condition for allowance. This application is therefore in condition for allowance. Reconsideration and allowance of the application are respectfully requested.

Respectfully submitted,



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